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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,407	07/24/2003	Samih Tarabichi	8696-1	1058
38635	7590	10/25/2005		
ADAMS AND REESE, L.L.P. 4500 ONE SHELL SQUARE NEW ORLEANS, LA 70139-4596			EXAMINER HOEKSTRA, JEFFREY GERBEN	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/626,407

Applicant(s)

TARABICHI, SAMIH

Examiner

Jeffrey G. Hoekstra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20051019.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 07/24/2003 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the -- opto-microelectronic device-- must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because of -- legalese --. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities: -- legalese --.

Appropriate correction is required.

6. The examiner notes regarding claims 2, 3, 5, and 6 that the applicant used the "means plus function" terminology but is not invoking 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuke et al (5800438). Tuke discloses a dynamic spacer for measuring the flexion and extension gaps during knee arthroplasty having parallel first 1 and second 8 planar members with lower 40 and upper 41 surfaces engaging tissue surfaces, respectively. Wherein said members fixedly attach a tensioning means shown in Figure 2. For claim 2, Tuke shows the spacer is used for measuring distance between said first and second planar members (column 3 line 66).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Muhs et al (5701370). Tuke discloses the claimed invention except for measuring distance with an opto-microelectronic device with a digital output means, a means for measuring angulation, and for measuring angulation with opto-microelectronic device. Muhs teaches the measurement of various rotation angles in a knee (column 3 line 33) as a planar member deviates from parallel and also the measurement of distance and angle with an opto-microelectronic device 70 with a digital

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output means 104 for displaying and recording. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the dynamic spacer for total knee arthroplasty as taught by Tuke, with Muhs for the purpose of digitally measuring and displaying distance and angle.

11. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka (6716043). Tuke discloses the claimed invention except for a tensioning means comprising a plurality of compressive coil springs wherein said springs are encapsulated in a plurality of segmented cylindrical spring housings wherein upper and lower segmented portions have different diameters and are slidably engaged. Ishizuka teaches the use of a plurality of compressive coil springs 12 for tensioning mean. Moreover, Ishizuka teaches a plurality of segmented cylindrical spring housings encapsulating said plurality of compressive coil springs wherein said segments are of differing diameters in order to be slidably engaged, best seen in Figures 2 and 4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the dynamic spacer for total knee arthroplasty as taught by Tuke, with Ishizuka for the purpose of creating tension with a plurality of compressive coil springs encased in slidably engaged segmented housings.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka as applied to claims 7 and 8 above, and further in view of Weisman et al (3722100). Tuke in view of Ishizuka discloses the claimed invention except for segmented cylindrical housing having graduated indices for measuring distance. Weisman teaches a segmented cylindrical housing 16, 36 with graduated indices as

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seen in Figure 2 for measuring distance. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the dynamic spacer for total knee arthroplasty as taught by Tuke in view of Ishizuka, with Weisman for the purpose of measuring and displaying distance.

13. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka and Weisman as applied to claim 9 above, and further in view of Muhs. Tuke in view of Ishizuka in further view of Weisman discloses the claimed invention except for measuring angulation and additionally comprising a fixedly attached positioner. Muhs teaches measuring angulation by deviation of a planar member as it deviates from parallel wherein a positioner is fixedly attached to the lower tensioning surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the dynamic spacer for total knee arthroplasty as taught by Tuke in view of Ishizuka in further view of Weisman, with Muhs for the purpose of measuring angulation of the knee during total knee arthroplasty.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

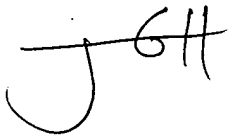
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH



MAX F. HINDENBURG  
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